

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77722665
LAW OFFICE ASSIGNED	LAW OFFICE 112
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The examining attorney is refusing registration based on descriptiveness; the applicant however is requesting this application be amended to the Supplemental Register.</p> <p>The examining attorney is refusing registration based on a possible likelihood of confusion. Applicant, however, does not believe such a possible likelihood of confusion exists.</p> <p>In testing for likelihood of confusion under Sec. 2(d), the following, when of record, must be considered:</p> <ol style="list-style-type: none"><li>1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.</li><li>2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.</li><li>3. The similarity or dissimilarity of established, likely-to-continue trade channels.</li><li>4. The conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing.</li><li>5. The fame of the prior mark (sales, advertising, length of use).</li><li>6. The number and nature of similar marks in use on similar goods.</li><li>7. The nature and extent of any actual confusion.</li><li>8. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.</li></ol>	

9. The variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark).
10. The market interface between applicant and the owner of a prior mark:
  - a. a mere 'consent' to register or use.
  - b. Agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
  - c. Assignment of mark, application, registration and goodwill of the related business.
  - d. Laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. The extent of potential confusion, i.e. whether de minimis or substantial.
13. Any other established fact probative of the effect of use.

The points of comparison for a word mark are appearance, sound, and meaning or connotation.

Similarity of the marks in one respect – sight, sound or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. Rather, the rule is that taking into account all of the relevant facts of a particular case, similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar. In re Lamson Oil Co., 6 USPQ2d 1041, 1042 n. 4 (TTAB 1987).

**The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression and the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.**

These marks are clearly different from each other. The registered mark is for IOBYTE whereas applicant's mark is for IOBIT. While both marks start with the letters "IO", the final syllable of each word differs greatly – both in pronunciation and in meaning. As the examining attorney stated:

- Merriam-Webster Online Dictionary (2010):

· <http://www.merriam-webster.com/dictionary/bit> (defining “bit” as “a unit of computer information equivalent to the result of a choice between two alternatives”);

· <http://www.merriam-webster.com/dictionary/byte> (“a unit of computer information or data-storage capacity that consists of a group of eight bits and that is used especially to represent an alphanumeric character”);

While both are computer terms, they define very different things which would be immediately apparent to the sophisticated users of these goods. Furthermore, “bit” is pronounced ?bit whereas “byte” is pronounced ?b?t, which is also something that would be immediately known and apparent to the sophisticated users of the goods associated with the marks. These marks are very different in both pronunciation and meaning.

**The conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.**

Applicant’s mark is associated with high technology products, geared toward consumers who are demanding and passionate regarding the products. The goods are geared to individuals with very specific needs and desires regarding the products they are purchasing.

**The fame of the prior mark (sales, advertising, length of use).**

Applicant has been using this mark in business extensively since at least as early as May 25, 2005. This mark has become distinctive to the goods and services offered by the applicant.

**The number and nature of similar marks in use on similar goods.**

There are currently 132 live pending applications/registered marks in International Class 009 containing the word “bit”, 57 live pending applications/registered marks in International Class 009 containing the word “byte”, and 45 live pending applications/registered marks in International Class containing “IO” as a major portion of the mark. These are common terms.

**The nature and extent of any actual confusion.**

Applicant has been using this mark in business worldwide, in association with these goods, for over five

years now with no actual confusion regarding the source of the goods.

Therefore applicant requests this application be allowed to proceed to registration.

## **GOODS AND/OR SERVICES SECTION (current)**

**INTERNATIONAL CLASS**

**009**

### **DESCRIPTION**

Computer utility program recorded on data media; optical discs; computer operating program recorded on data media; computer software for performing computer maintenance work recorded on data media; magnetic data storage media; disc drivers for computers; downloadable electronic publications in the nature of software in the field of computer maintenance; downloadable computer program for performing computer maintenance work

**FILING BASIS**

**Section 1(a)**

**FIRST USE ANYWHERE DATE**

**At least as early as 05/05/2005**

**FIRST USE IN COMMERCE DATE**

**At least as early as 05/05/2005**

## **GOODS AND/OR SERVICES SECTION (proposed)**

**INTERNATIONAL CLASS**

**009**

### **TRACKED TEXT DESCRIPTION**

Computer utility program recorded on data media; optical discs; computer operating program recorded on data media; computer software for performing computer maintenance work recorded on data media; magnetic data storage media; disc drivers for computers; ~~downloadable electronic publications in the nature of software in the field of computer maintenance~~; downloadable computer program for performing computer maintenance work

### **FINAL DESCRIPTION**

Computer utility program recorded on data media; optical discs; computer operating program recorded on data media; computer software for performing computer maintenance work recorded on data media; magnetic data storage media; disc drivers for computers; downloadable computer program for performing computer maintenance work

**FILING BASIS**

**Section 1(a)**

**FIRST USE ANYWHERE DATE**

**At least as early as 05/05/2005**

**FIRST USE IN COMMERCE DATE**

**At least as early as 05/05/2005**

## **ADDITIONAL STATEMENTS SECTION**

**SUPPLEMENTAL REGISTER**

The applicant seeks registration of the mark on the Supplemental Register (i.e., a change of the words 'Principal Register' to 'Supplemental Register').

**SIGNATURE SECTION****RESPONSE SIGNATURE**

/jmf/

**SIGNATORY'S NAME**

Jeffrey M. Furr

**SIGNATORY'S POSITION**

Attorney of record

**DATE SIGNED**

08/27/2010

**AUTHORIZED SIGNATORY**

YES

**CONCURRENT APPEAL NOTICE FILED**

YES

**FILING INFORMATION SECTION****SUBMIT DATE**

Fri Aug 27 09:00:24 EDT 2010

**TEAS STAMP**USPTO/RFR-67.142.130.15-2  
0100827090024962401-77722  
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8fe65cf71de82-N/A-N/A-201  
0082708525792222P123 Furr (Trev Aug 2010)  
FAME No. 123456789 (1640) 08-31-2014**Request for Reconsideration after Final Action  
To the Commissioner for Trademarks:**

Application serial no. **77722665** has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

The examining attorney is refusing registration based on descriptiveness; the applicant however is requesting this application be amended to the Supplemental Register.

The examining attorney is refusing registration based on a possible likelihood of confusion. Applicant, however, does not believe such a possible likelihood of confusion exists.

In testing for likelihood of confusion under Sec. 2(d), the following, when of record, must be considered:

1. The similarity or dissimilarity of the marks in their entireties as to appearance,

sound, connotation and commercial impression.

2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
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8. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.
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into account all of the relevant facts of a particular case, similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar. In re Lamson Oil Co., 6 USPQ2d 1041, 1042 n. 4 (TTAB 1987).

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**The nature and extent of any actual confusion.**

Applicant has been using this mark in business worldwide, in association with these goods, for over five years now with no actual confusion regarding the source of the goods.

Therefore applicant requests this application be allowed to proceed to registration.

**CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 009 for Computer utility program recorded on data media; optical discs; computer operating program recorded on data media; computer software for performing computer maintenance work recorded on data media; magnetic data storage media; disc drivers for computers; downloadable electronic publications in the nature of software in the field of computer maintenance; downloadable computer program for performing computer maintenance work

Original Filing Basis:

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 05/05/2005 and first used in commerce at least as early as 05/05/2005, and is now in use in such commerce.

**Proposed:**

**Tracked Text Description:** Computer utility program recorded on data media; optical discs; computer operating program recorded on data media; computer software for performing computer maintenance work recorded on data media; magnetic data storage media; disc drivers for computers; ~~downloadable electronic publications in the nature of software in the field of computer maintenance;~~ downloadable computer program for performing computer maintenance work

Class 009 for Computer utility program recorded on data media; optical discs; computer operating program recorded on data media; computer software for performing computer maintenance work recorded



on data media; magnetic data storage media; disc drivers for computers; downloadable computer program for performing computer maintenance work

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 05/05/2005 and first used in commerce at least as early as 05/05/2005, and is now in use in such commerce.

#### **ADDITIONAL STATEMENTS**

##### **Supplemental Register**

The applicant seeks registration of the mark on the Supplemental Register (i.e., a change of the words 'Principal Register' to 'Supplemental Register').

#### **SIGNATURE(S)**

##### **Request for Reconsideration Signature**

Signature: /jmf/ Date: 08/27/2010

Signatory's Name: Jeffrey M. Furr

Signatory's Position: Attorney of record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77722665

Internet Transmission Date: Fri Aug 27 09:00:24 EDT 2010

TEAS Stamp: USPTO/RFR-67.142.130.15-2010082709002496

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